

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed July 20, 2009. Currently, claims 31-37, 39, and 68-74 remain pending. Claims 31-37, 39, and 68-74 have been rejected and claim 36 been objected to. Claim 36 has been canceled. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 103

Claims 31, 32, 35-36, and 39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. (U.S. Patent No. 6,485,501), hereinafter Green, in view of Grayhack et al. (U.S. Patent No. 4,611,594), hereinafter Grayhack, and further in view of Bagaoisan et al. (U.S. Patent No. 6,152,909), hereinafter Bagaoisan. After careful review, Applicant must respectfully traverse this rejection.

With regard to the Response to Arguments, Applicants must respectfully disagree with the Examiner's characterization of the limitation of claim 31 which recites: "wherein the proximal end of the retrieval adapter is configured to engage and couple with a distal end of an interventional device *within the vessel*" as not limiting the structure. The plain language of the claim recites that the structure must be capable of engaging within the vessel and must be capable of coupling within the vessel. Given the phrase in question, one of ordinary skill in the art would not read either:

... wherein the proximal end of the retrieval adapter is configured to engage ... a distal end of an interventional device within the vessel...

or

... wherein the proximal end of the retrieval adapter is configured ... to couple with a distal end of an interventional device within the vessel ...

to suggest that "engage" and "couple" are being used as adjectives instead of as verbs. Had that been the intent, Applicants would have used the adjectival forms of those words and would have claimed:

... wherein the proximal end of the retrieval adapter is configured to be engaged and coupled with a distal end of an interventional device within the vessel ...

Thus the apparatus of Green, which appears to be engaged and coupled at the time of insertion into the vessel, does not appear to have structures which are capable of either engaging or coupling within the vessel for the simple reason that they do not appear to have been disengaged and/or uncoupled at any time while they are within the vessel. On the contrary, they appear to be permanently integrated in Fig. 28. The Examiner's position that the components of Green are, at some point "engaged (thus capable of being engaged) and coupled (thus capable of being coupled)" does not adequately address the claimed limitation for at least the reason that, as described at column 10, lines 60-62, "As seen in FIG. 30, a capture tip 380 is integrated with a stent delivery system 385, or with a PTCA catheter (not shown)" (emphasis added) indicating in the cited Figs. 29 and 30 that the two components are a single integrated unit throughout the procedure. Instead of teaching a separate capture sheath and interventional device, the stent delivery system, Green appears to teach: "This avoids an exchange of systems to provide for a dedicated capture sheath." thereby teaching away from a separate capture sheath to be used in conjunction with an interventional device and Green appears to be directed toward avoiding the presence of separate elements. Further, there appears to be no structure disclosed in Figures 29 and 30 which would appear to be capable of coupling within the vessel. As depicted, there does not appear to be any structure which would even allow the capture tip and stent delivery system to align, much less couple, within the vessel were they to be introduced separately.

Secondly, the Examiner's position appears to ignore the limitation that the engagement and coupling functions are limited to structures which are capable of doing so within the vessel and to rely instead upon inherency of the ability to both engage and couple at some unspecified place and time.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (Emphasis added.)

Green has indicated that the structures which the Examiner asserts are capable of engaging and coupling are “integrated” in the catheter in question. Nothing in the disclosure of Green appears to indicate that the structures are inherently capable of existing as separate entities within the vessel and nothing in the disclosure appears to indicate that they engage and couple within the vessel as those terms are used in the pending specification and claims.

engage (vt.): To interlock or cause to interlock; mesh

couple (vt.): To link together; connect

(Compact Oxford English Dictionary)

Green does not appear to disclose that the tip and the stent delivery system provide structure(s) which are initially separated within the vessel and which are configured to interlock and link together within the vessel, but instead discloses that they form an “integrated” structure. The inherency of the integrated apparatus of Green to engage and couple within the vessel does not appear to be supported by Green or established by the Examiner’s response. (MPEP 2112, IV.)

In the absence of the structure incorrectly attributed to Green by the Examiner and in view of the fact that Green apparently teaches away from a structure which is not integrated, Green does not appear to teach or to suggest the elements of claim 31. Additionally, nowhere do Grayhack and Bagaoisan appear to remedy the deficiencies of Green. Therefore, Green in view of Grayhack and Bagaoisan does not appear to teach all the claim limitations, as is required to establish a *prima facie* case of obviousness.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

Accordingly, claims 32, 35-36, and 39, which depend from nonobvious independent claim 31, also are believed to be nonobvious and Applicants respectfully request that the rejections be withdrawn.

Claims 33 and 34 were rejected under 35 U.S.C. 103(a) as being unpatentable

over Green in view of Grayhack and Bagaoisan and further in view of Ferrera et al. (U.S. Patent No. 6,240,231), hereinafter Ferrera. After careful review, Applicant must respectfully traverse this rejection.

Claim 37 was rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Grayhack and Bagaoisan and further in view of Ha et al. (U.S. Patent No. 6,159,195), hereinafter Ha. After careful review, Applicant must respectfully traverse this rejection.

Each of the above rejections depends upon structure incorrectly attributed to Green by the Examiner, an incorrect reading of the plain language of claim 31, and upon ignoring the fact that Green apparently teaches away from a structure which is not integrated. The addition of various elements attributed to the remaining references does not appear to overcome the deficiencies of Green and so the various combinations do not appear to teach all the claim limitations, as is required to establish a *prima facie* case of obviousness. For at least these reasons, Applicants believe that independent claim 31 is nonobvious over the cited references in combination.

Further, claims 32-35, 37, and 39, which depend from nonobvious independent claim 31, also are believed to be nonobvious and Applicants respectfully request that the rejections be withdrawn.

Claims 68, 69, 72, and 74 were rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Grayhack and Bagaoisan and further in view of Bleam et al. (U.S. Patent No. 6,143,016), hereinafter Bleam. After careful review, Applicant must respectfully traverse this rejection.

Claims 70 and 71 were rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Grayhack, Bagaoisan, and Bleam and further in view of Ferrera. After careful review, Applicant must respectfully traverse this rejection.

Claim 73 was rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Grayhack, Bagaoisan, and Bleam and further in view of Ferrera and further in

view of Ha. After careful review, Applicant must respectfully traverse this rejection.

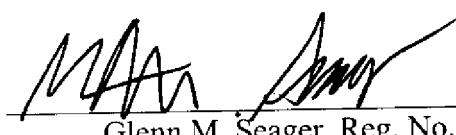
Each of the above rejections appears to depend upon a "modified Green" asserted to exist by the Examiner, but without an indication of which elements are supposedly found in Green, where those elements of claim 68 are to be found, or even which modifications to Green are postulated to be present in the "modified Green" referred to by the Examiner. The claims in question were presented in the most recent communication and so have not been previously discussed by the Examiner and so no guidance appears to be present upon which to base a response. In the absence of identified elements within the reference(s) corresponding to all elements of the claim, the rejection of independent claim 68 does not appear to establish a *prima facie* case of obviousness and Applicants respectfully request that the rejection be withdrawn.

Further, claims 69-74, which depend from nonobvious independent claim 68, also are believed to be nonobvious and Applicants respectfully request that the rejections be withdrawn.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date: Sept 11, 2009



Glenn M. Seager, Reg. No. 36,926
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Glenn.Seager@cstlaw.com
Tel: (612) 677-9050
Fax: (612) 359-9349